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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/526,594

03/04/2005

Shinya Yoshida

62,817 (70801)

5793

21874

7590

01/29/2009

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EXAMINER

BLOUIN, MARK S

ART UNIT

PAPER NUMBER

2627

MAIL DATE

DELIVERY MODE

01/29/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/526,594	YOSHIDA, SHINYA	
	<b>Examiner</b>	<b>Art Unit</b>	
	MARK BLOUIN	2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11/24/08.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 4 and 7-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4 and 7-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **Detailed Action**

### ***Response to Amendment***

- The reply filed on November 24, 2009 was applied to the following effect: Claims 1-3,5, and 6 were cancelled, Claims 4,7,8, 10-18, and 23-26 were amended, Claims 28-41 are added.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 4,7,11-13,15-17,19-21, 23,25,and 28-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (USPub 2001/0030929) in view of Smith et al (US 5,579,296).
3. Regarding Claims 28 and 29, Sato et al shows (Fig. 8), an optical recording medium having data optically recorded on a substrate having a flat first face to be fixed to a chuck by magnetic force, the chuck having an annular protrusion for determining a rotation center, and a flat second face which is the reverse face of the first face, the optical recording medium comprising: a disk-shaped magnetic element (103) integrated in the substrate at the center portion of the first face, for generating the magnetic force; and an annular recess arranged around the disk-shaped magnetic element of the first face so that the annular protrusion fits into the annular recess, but does not show a design is put on the center portion of the second face.

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Smith et al shows (Fig. 29) the flat face having a design is put on the center portion of the second face.

One of ordinary skill in the art would have been motivated to have provided the flat surface of Ono with the design as taught by Smith in order to block light (as layer 31 of Ono does), and identify a particular disk and the information stored on that disk

4. Regarding Claim 4 and 30-32, Sato et al shows (Figs. 8), an optical recording medium characterized in that the annular recess (101a) has an arc or triangle cross-section, and each corner between the arc or triangle and the second face forms an obtuse angle when seen in cross section.

5. Regarding Claims 11,15, and 19 Sato et al (Fig. 8) in view of Smith (Figs. 1-31) an optical recording medium characterized in that the substrate is composed of one plastic substrate, and the design put on the other face of the plastic substrate is formed by means of printing (product by process).

6. Regarding Claims 6,12,16,20, 35, and 36, Sato et al (Fig. 8) in view of Smith (Figs. 1-31) an optical recording medium characterized in that the substrate is composed of one plastic substrate (102) and the other face of the plastic substrate has optical data recorded thereon, the other face being provided with an adhesive layer and a cover layer attached by the adhesive layer, the design being put on a surface of the cover layer.

7. Regarding Claims 7,13,17,21,23, and 25 Sato et al (Fig 8) in view of Smith shows , an optical recording medium characterized in that the substrate has a metal piece (103) or a magnetic element integrated therein.

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8. Regarding Claims 33 and 34, Sato et al (Fig. 8) in view of Smith (Figs. 1-31) an optical recording medium characterized in that design is printed on a resin layer formed on the second face (product by process).

9. Regarding Claims 37 and 38, Sato et al (Fig. 8) in view of Smith (Figs. 1-31) an optical recording medium characterized in that the cover layer is a metal foil or lenticular lens.

10. Claims 8-10,14,18, 22,24,26,27,and 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato et al (USPub 2001/0030929) in view of Smith et al (US 5,579,296) in further view of Ono et al (6,680,897).

11. Regarding Claims 8-10,14,18,22,24,26,27,and 39-41, Sato et al in view of Smith et al shows all the features described, *supra*, but does not show an optical recording medium characterized in that the optical recording medium has a memory integrated therein, characterized in that the memory is a nonvolatile semiconductor memory, characterized in that the optical recording medium, has an antenna which is connected to the memory integrated therein.

Ono et al shows (Figs. 1-14), an optical recording medium characterized in that the optical recording medium has a memory (3) integrated therein, characterized in that the memory is a nonvolatile semiconductor memory (3), characterized in that the optical recording medium has an antenna (10) which is connected to the memory integrated therein.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the optical disk of Sato in view of Smith with the memory as taught by Ono in order to store and transmit data in and from the optical disk

***Response to Arguments***

12. Applicant's arguments with respect to claims 4 and 7-41 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Blouin whose telephone number is 571-272-7583. The examiner can normally be reached on M-F from 6:00 to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joe Feild, can be reached on 571-272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Blouin/

Primary Examiner of Art Unit 2627

Mark Blouin  
Patent Examiner  
Art Unit 2627  
January 23, 2009